

Applicant : Boguslaw Swedek et al.
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Attorney's Docket No.: 05542-451001 / 5252/CMP

REMARKS

Claims 1-5 and 16-22 are pending in the application.

Claims 1, 2, 4, 16, and 17 stand rejected under 35 U.S.C. 102(e) as allegedly being anticipated by U.S. Patent No. 6,433,541 to Lehman et al. ("Lehman"). Claims 3 and 5 stand rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Lehman without a secondary reference.

In view of the remarks herein, Applicant respectfully traverses the rejections and asks that they be withdrawn. Applicant also respectfully requests that the finality of the office action be withdrawn.

I. ALLOWABLE SUBJECT MATTER

Applicant gratefully acknowledges the indication of allowable subject matter.

II. THE REJECTIONS UNDER 35 U.S.C. 102(E) AND 35 U.S.C. 103(A)

Claims 1 and 16

The office action rejects Applicant's arguments submitted in the Response filed on September 18, 2003 because claims 1 and 16 are apparatus claims, and asserts that the function of the structure is of no patentable consequence in an apparatus claim.

Applicant directs the Examiner's attention to MPEP 2173.05(g), which states that "There is nothing inherently wrong with defining some part of an invention in functional terms." "A functional limitation must be evaluated and considered, just like any other limitation of the claim..." The Federal Circuit has recently affirmed that functional limitations are now entitled to patentable weight. "A patent applicant is free to recite features of an apparatus either structurally or functionally." *In re Schreiber*, 128 F.3d 1473, 1478, 44 USPQ.2d 1429, 1432 (Fed. Cir. 1997).

The example at the end of MPEP 2173.05(g) outlines the acceptance of functional limitations and their patentability. The MPEP cites *In re Venezia*, 530 F.2d 956, 189 USPQ 149 (CCPA 1976), in which a claim directed to a kit of component parts capable of being assembled included limitations such as "members adapted to be positioned," and found that the functional

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limitations serve to precisely define present structural attributes of interrelated component parts of the claimed assembly.

Claim 1 is similar. Claim 1 includes the feature (not found in or suggested by Lehman) "circuitry in the platen to combine the first signal from the eddy current monitoring system and second signals from the optical monitoring system into a third signal on an output line." In order to satisfy its burden, the office action must point to a teaching that such circuitry is included in the platen of Lehman, or some suggestion for providing such circuitry. Applicant finds no such teaching or suggestion.

Claim 16 is more similar to the apparatus claim in *In re Beauregard*. In that case, the Commissioner of Patents and Trademarks stated that "computer programs embodied in a tangible medium, such as floppy diskettes, are patentable subject matter under 35 U.S.C. § 101 and must be examined under 35 U.S.C. § 102 and § 103." *In re Gary M. Beauregard, Larry K. Loucks, Khoa Dang Nguyen and Robert J. Urquhart*, 53 F.3d 1583, 33 USPQ 2d 1383 (Fed. Cir. 1995). In view of the Commissioner's statement in *In re Beauregard*, the Examiner must evaluate claim 16 under 35 U.S.C. §§ 102 and § 103, rather than dismissing the limitations as functional. For the reasons stated in the previous reply, Applicant finds no teaching or suggestion in Lehman of the feature "a computer configured to calculate a correction factor based on the strength of the magnetic field and calculate a thickness of the conductive layer from the phase difference and the correction factor," as recited in claim 16.

Claim 17

The office action additionally fails to point to a teaching or suggestion in Lehman of "an eddy current monitoring system to generate a first signal during polishing, the eddy current monitoring system including a coil wrapped around a core to generate a magnetic field that extends to a first region of the substrate; an optical monitoring system positioned to generate a second signal during polishing, the optical monitoring system including a light source, the light source positioned and oriented to direct a light beam to a spot in the first region of the substrate so that the eddy current monitoring system and optical monitoring system measure substantially the same location on the substrate."

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As noted in the previous reply, there is no teaching or suggestion in Lehman that a coil is "wrapped around a core" and also "the eddy current monitoring system and optical monitoring system measure substantially the same location on the substrate." Applicant finds no response to these arguments in the office action, and assumes that the claim was rejected because it includes some functional language. For the reasons stated above, this rejection is improper.

Claims 3 and 5

Claims 3 and 5 depend from claim 1, and are therefore patentable for at least the reasons stated above with respect to claim 1.

III. THE FINALITY OF THE OFFICE ACTION

In view of the arguments above, Applicant requests that the finality of the office action be withdrawn. MPEP 706.07 states that "Before final rejection is in order a clear issue should be developed between the examiner and applicant." Since the final office action incorrectly applied the law, no clear issue exists at this time. Therefore, Applicant believes the finality is premature and asks that it be withdrawn.

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CONCLUSION

In view of the remarks above, Applicant believes pending claims 1-5 and 16-22 are in condition for allowance. If the Examiner has any questions regarding this response, the Examiner is invited to call the undersigned at (858) 678-5070.

Respectfully submitted,

Date: _____

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